

## REMARKS

Favorable reconsideration of this application, in view of the present amendments and in light of the following discussion, is respectfully requested.

Claims 1, 2 and 5-10 are pending in the present application. Claims 3 and 4 are canceled without prejudice or disclaimer, claim 1 is amended and new claims 6-10 are added by the present Response.

As an initial matter, Applicant thanks the Examiner for acknowledging consideration of the materials submitted in the IDS filed June 10, 2004, for indicating acceptance of the Drawings (as noted in item 10 of the Office Action Summary), and for acknowledging the claim to priority and receipt of the certified copy of the priority document for this application (as noted in item 12 of the Office Action Summary).

## REJECTIONS UNDER 35 U.S.C. § 102

In the outstanding Office Action, claims 1-4 were rejected under 35 U.S.C. § 102(b) in view of U.S. Patent No. 6,066,102 to Townsend et al. (herein "TOWNSEND"). This rejection is respectfully traversed.

Independent claim 1 is amended to recite the features of claim 3 which depended therefrom (accordingly, claim 3 and claim 4, which recited features similar to claim 3, are canceled), and recites, *inter alia*, "a pair of pivots such that one pivot of said pair of pivots is arranged on one side of

the axis and another pivot of said pair of pivots is arranged on another side of the axis, at the front-end section of said flexible sheath," in which "each of said limbs is separately rotatable about a respective pivot of said pair of pivots, and said water supply channel passes between said pair of pivots."

In a non-limiting example, FIGS. 1 and 2 show two pincerlike high-frequency electrodes 4 which are journaled onto their respective pivots 5, so that the pair of pincerlike high-frequency electrodes 4 can be made to open and close (see the specification at page 4, line 21 to page 5, line 1). Also, FIG. 5 shows the two pivots 5 are arranged in parallel with each other with the center axis of the fore-end member 2 between them, and a water supply channel (for example, the round circle in the center of the figure) passes between the two pivots 5 (see the specification at page 4, lines 15-20).

In contrast, TOWNSEND in FIG. 6 and at col. 8, lines 1-5 thereof recites that "flats 96 each have a pivot pin 100 disposed thereon." The pivot pin 100 "couples with the cut out 138 in each of the cutting jaws 120" (see, for example, FIG. 3 of TOWNSEND) and "allows the cutting jaws 120 to rotate about the pivot pin 100." That is, TOWNSEND merely discusses that each pair of "cutting jaws 120" is coupled with a single "pivot pin 100;" thus there is no disclosure in TOWNSEND of "a pair of pivots" in which "each of said limbs is separately rotatable about a respective pivot of said pair of pivots," as recited in pending amended independent claim 1.

Moreover, because FIG. 16f of TOWNSEND merely shows the single pivot similar to the single "pivot pin 100" discussed above, TOWNSEND thus also does not disclose a "water supply channel" which "passes between said pair of pivots," as recited in pending amended independent claim 1.

Therefore, TOWNSEND does not disclose each and every feature recited at least in pending amended independent claim 1, and the rejection of claim 1 under 35 U.S.C. §102(b) is improper. Thus, it is respectfully submitted that pending amended independent claim 1 and each of the claims depending therefrom patentably distinguish over TOWNSEND. Accordingly, it is respectfully requested this rejection be withdrawn.

### **REJECTION UNDER 35 U.S.C. § 103**

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over TOWNSEND and U.S. Patent No. 5,330,471 to Eggers (herein "EGGERS"). This rejection is also respectfully traversed.

Claim 5 depends on amended independent claim 1, which as discussed above is believed to patentably distinguish over TOWNSEND. Furthermore, assuming *arguendo* the combination of TOWNSEND and EGGERS may be properly made, EGGERS merely relates to endoscopic surgical instruments having bipolar electrodes on opposing movable members. However, similarly to TOWNSEND, EGGERS also does not

teach or suggest at least "a pair of pivots such that one pivot of said pair of pivots is arranged on one side of the axis and another pivot of said pair of pivots is arranged on another side of the axis, at the front-end section of said flexible sheath," in which "each of said limbs is separately rotatable about a respective pivot of said pair of pivots, and said water supply channel passes between said pair of pivots," as recited in pending amended independent claim 1.

Accordingly, it is respectfully submitted neither TOWNSEND nor EGGERS, either alone or in any proper combination thereof, teach or suggest all the features of pending amended independent claim 1 or the claims depending therefrom; and it is respectfully requested this rejection also be withdrawn.

## **NEW CLAIMS**

In addition, new claims 6-10, which depend on amended independent claim 1, are added to set forth the invention in a varying scope. Support for new claim 6 is found at least in FIGS. 3 and 4 and the specification at page 4, lines 2-8, page 6, lines 2-11 and page 7, lines 9-16; support for new claim 7 is found at least in FIG. 2 and the specification at page 5, line 18 to page 6, line 11; support for new claim 8 is found at least in FIG. 1 and the specification at page 6, lines 12-18; support for new claim 9 is found at least in FIG. 1 and the specification at page 5, lines 2-7; and

support for new claim 10 is found at least in FIG. 4 and the specification at page 4, lines 9-14.

New claims 6-10 are believed to be patentable at least for reasons similar to those discussed above regarding amended independent claim 1, from which new claims 6-10 depend. Moreover, new claims 6-10 are believed to even further patentably distinguish over the cited art at least because of the additional features recited therein (and not taught or suggested by the cited art). It is believed no new matter is added by new claims 6-10.

#### **AMENDMENTS TO THE SPECIFICATION**

Further, the Title is amended to more directly reflect the subject matter to which the claims are directed. Also, the Abstract is amended to better conform to standard patent practice. It is believed no new matter is added by the amendments to the Title and Abstract.

#### **CONCLUSION**

Consequently, in light of the above discussion and in view of the present amendments, this application is believed to be in condition for allowance.

Accordingly, consideration of the present Response, reconsideration of the outstanding Office Action, and allowance of the present application and all of the claims pending therein is respectfully requested.

The amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based on the cited art, should thus be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to have attached thereto.

Applicant has made a sincere effort to place the present application in condition for allowance and believes he has now done so.

If the Examiner has any questions concerning this Response or the present application, Applicant respectfully invites the Examiner to contact the undersigned at the telephone number listed below.

Respectfully Submitted,  
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